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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/297,703	07/19/1999	STEPHEN A. JOBLING	CASE#1637	1158

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EXAMINER

KUBELIK, ANNE R

ART UNIT PAPER NUMBER

1638

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/297,703

Applicant(s)

JOBLING ET AL.

Examiner

Anne R. Kubelik

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 3/12/04 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 12 March 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): Objection to claim 37. 112, 2nd, over claim 38.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☒ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 33-35, 42 and 60-65.

Claim(s) objected to: _____

Claim(s) rejected: 36-40.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☒ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because:

112, 1st, enablement over claims 36-40: Applicant urges that Kiel et al teaches the construction of plasmid pKVB2, which is based on pBR322, and its transformation into E coli JM83 to produce KV832, as well as the advantages of the mutation system taught by Kiel et al and the advantages of using pBR322-based plasmids. This is not found persuasive. The construction of KV832 requires the plasmid pKVB2, which was made from plasmids pOP190 and pKM1. None of these plasmids appear to be publically available and the sequences of none are available in GenBank. Furthermore, even if plasmid pKVB2 or the vectors from which it was made were available, it is not clear that strain KV832 has no other mutations in any other gene, compared to JM83, after the 50 subculturings required to make the strain. It is also not clear that other mutations (for example point mutations) were not introduced in the glgB region of the strain, as compared to JM83. Thus, it is not clear that strain KV832 could be exactly duplicated by the method of Kiel et al, even if a similar strain could be made.

Applicant urges that it is not necessary to teach the mutation in glgB that is present in KV832 because the strain was used in complementation analysis and the reference teaches a repeatable method to produce KV832. This is found partially persuasive. The general deletion that makes up the glgB mutation in KV832 is clear from Kiel et al, however, the exact mutation is not known because the plasmid is not sequenced. It is however, clear from the specification and from Kiel et al that knowledge of the nature of the mutation is not necessary to perform the complementation analysis. The strain itself, however, is required.

Applicant urges that a deposit of KV832 is thus not required. This is not found persuasive for the reasons indicated above.

A handwritten signature in black ink, appearing to be "James H. [unclear]", written in a cursive style.